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REMARKS

Claims 1 through 11, 16 through 20 and new Claim 21 are pending in the application.

Applicants acknowledge with gratitude the Examiner's indication that Claim 20 has been allowed, as the art of record does not teach or suggest the recited beneficial tensile properties.

Accordingly, solely to advance prosecution of the case, Claim 1 has been amended to reflect the advantageous tensile properties of Claim 20. Claim 1 has more particularly been amended to recite that in advantageous embodiments the films of the invention exhibit a modulus of elasticity in the transverse direction of greater than or equal to 4200 N/mm². Support for this amendment can be found in the Application-as-filed, for example on Page 3, lines 8 through 11.

Claims 1, 2, 3, 4, 6, 7, 16 and 19 have been amended to remove the term "crystallizable."

Applicants further acknowledge with gratitude the Examiner's indication that Claims 7 and 8 are allowable in light of the art of record.

Claim 16 has further been amended to include additional clarifying language reflecting that in advantageous embodiments the films of the invention are formed from thermoplastic consisting solely of polyester. Support for this amendment can be found in the Application-as-filed, for example on Page 4, lines 1 through 4.

Claim 21 has been added to complete the record for examination and highlight advantageous embodiments of the invention.

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Claim 21 has been added to provide alternative clarifying language indicating that in advantageous embodiments the films of the invention are formed from thermoplastic consisting solely of polyester. Support for Claim 21 can be found in the Application-as-filed, for example on Page 4, lines 1 through 4.

Applicants respectfully submit that this response does not raise new issues, but merely places the above-referenced application either in condition for allowance, or alternatively, in better form for appeal. Reexamination and reconsideration of this application, withdrawal of all rejections, and formal notification of the allowability of the pending claims are earnestly solicited in light of the following remarks.

Claim Status

Claims 1 through 5, 9 through 11 and 16 through 19 stand rejected over United States Patent No. 5,660,931 to Kim ("US 931") in view of United States Patent No. 6,641,924 to Peiffer et al. ("US 924"). Claim 6 stands rejected as unpatentable over the foregoing references and further in view of United States Patent No. 4,384,040 to von Meer. ("US 040").

Statement of Common Ownership

Prior to addressing the merits of the rejection, Applicants respectfully submit that US 924 does not constitute prior art against the above-referenced application. More particularly, the above-referenced invention, i.e. Application No. 09/779,156, and US 924 were, at the time the above-referenced invention was made, both subject to an obligation of assignment to Mitsubishi Polyester Film, GmbH. This statement is made in conformance with MPEP 706.02(1)(2). Accordingly, Applicants respectfully submit that US 924 does not constitute prior art against the above-referenced application under 35 USC 102 (e).

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Applicants further respectfully note that US 924 likewise does not constitute prior art against the above-referenced application under either 35 USC 102 (a) or 35 USC 102 (b).

Accordingly, Applicants respectfully submit that the foregoing rejections in light of US 924 have been obviated.

*The Claimed Invention is Patentable
in Light of the Remaining Art of Record*

It may be useful to briefly consider the invention as recited in the claims before addressing the merits of the rejection. The claims recite opaque, white films with a thickness of from 10 to 500 μm . The recited films are formed from thermoplastic that consists entirely of polyester, along with a pigment consisting entirely of barium sulfate and at least one optical brightener. The film further includes a functional coating having a thickness of from 5 to 10 nm.

Applicants have determined an advantageous combination of a particular pigment, i.e. barium sulfate, optical brightener, functional coatings and process conditions that provide a highly beneficial balance of physical properties within the resulting polyester films. More specifically, the opaque, white films of the invention provide good mechanical properties and good optical properties. In particular, the films of the invention advantageously exhibit a modulus of elasticity in the transverse direction of greater than or equal to 4200 N/mm^2 , as recited in Claim 1 as-amended.

The cited references do not teach or suggest the claimed invention.

US 931 is directed to low-weighted polymeric films having paper-like characteristics. (Col. 1, lines 57 – 58). The impetus of US 931 is the incorporation of polyolefin into paper substitutes to provide a suitably low density to the resulting film.

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(Col. 1, lines 60 – 67; Col. 2, lines 22 – 24 and Col. 3, lines 9 - 13). The polyolefin lowers the resulting film density by forming voids within the film. (Col. 4, lines 9 – 14). US 931 includes up to 40 parts by weight of the void-forming polyolefin into its films. (Col. 2, lines 61 – 64). Although imparting the intended density decrease, US 931 expressly notes that the void-forming polyolefin is “apt to deteriorate” the mechanical properties of the polyester. (Col. 1, lines 46 – 50).

Consequently, as correctly noted by the Examiner, US 931, considered either alone or in combination with the art of record, does not teach or suggest the advantageous tensile properties of the films of the invention. US 931 more particularly does not teach or suggest the advantageous films of the invention exhibiting a modulus of elasticity in the transverse direction of greater than or equal to 4200 N/mm^2 , as recited in Claim 1 as amended.

Applicants respectfully reiterate that US 931 also does not teach or suggest opaque, white film consisting entirely of polyester, as recited in Claims 1, 16 and 21. US 931 instead strongly teaches away from such films by requiring the presence of polyolefin.

The Office Action urges that the presence of an open transition phrase within a claim allows the inclusion of further additives. Applicants respectfully note that Claims 1, 16 and 21 do, in fact, recite an open transition phrase in regard to their non-thermoplastic components. However, Claims 1, 16 and 21 have been crafted so as to be fully closed with respect to suitable thermoplastic resins. Claim 21 has been crafted to provide a closed transition phrase immediately preceeding both the thermoplastic recitation and the polyester recitation, for example. Regarding the use of mixed transitional phrases within a claim, the Examiner's attention is kindly directed to *Berenter v Quigg*, 14 USPQ2d 1175 (D.D.C. 1988)(stating that “an applicant can leave the claim open with respect to additional elements, but can close the claim with respect to

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a particular element."'). Hence the required polyolefin of US 931 would clearly be excluded from Claims 1, 16 and 21.

Applicants respectfully submit that such absence of polyolefin would render the invention of US 931 inoperable, i.e. not useful as a synthetic paper. Accordingly, there would have been no suggestion or motivation to have made the proposed modification. MPEP 2143.01 (citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)).

Accordingly, Applicants respectfully submit that the claimed invention is patentable in light of US 931 considered either alone or in combination with the art of record.

As noted above, Applicants respectfully submit that US 924 does not constitute prior art against the above-referenced application.

Applicants respectfully submit that Claim 6 is likewise patentable in light of the art of record.

US 040 is directed to paper substrates coated with a highly pigmented, waterproof coating. The waterproofed paper substrates are subsequently coated with a photographic emulsion. (Col. 2, lines 24 – 27). The waterproof coating is formed from unsaturated polymerizable resins, such as vinyl monomers. (Col. 2, lines 38 – 41). Blue dye may be included within the waterproof coating, in an unspecified amount. (Col. 4, lines 19 – 21).

Applicants respectfully reiterate that there is no motivation to combine these references. US 931 is directed to biaxially oriented films used in packaging. US 040 is directed to photographic paper. These are altogether different fields of endeavor, to say the least.

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However, even if the cited references were combined (which Applicants submit should not be done), the claimed invention would not result. US 931 expressly requires polyolefin, which it further expressly notes to be detrimental to film properties. US 040 merely discloses dyed coatings on a paper substrate. Consequently, the combination of references does not teach or suggest the recited films formed from thermoplastic consisting entirely of polyester that exhibit a modulus of elasticity in the transverse direction of greater than or equal to 4200 N/mm^2 , much less such films incorporating a polyester-soluble blue dye, and most certainly not such films incorporating blue dye in an amount ranging from 10 to 10,000 ppm.

Accordingly, Applicants respectfully submit that Claim 6 is patentable in light of US 931 and US 040, considered either alone or in combination.

Based on the foregoing, Applicants respectfully submit that Claims 1 through 11 and 16 through 21 are patentable in light of the art of record, considered either alone or in combination.

CONCLUSION

It is respectfully submitted that Applicants have made a significant and important contribution to the art, which is neither disclosed nor suggested in the art. It is believed that all of pending Claims 1 through 11 and Claims 16 through 21 are now in condition for immediate allowance. It is requested that the Examiner telephone the undersigned if any questions remain to expedite examination of this application.

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It is not believed that extensions of time or fees are required, beyond those which may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time and/or fees are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required is hereby authorized to be charged to Deposit Account No. 50-2193.

Respectfully submitted,

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CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being transmitted to facsimile number (703) 872-9306 at the United States Patent and Trademark Office on June 7, 2005.

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